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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,151	01/13/2005	Joachim Hasch	P27125	9119

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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

THOMAS, ALEXANDER S

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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11/23/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary

Application No.

10/521,151

Applicant(s)

HASCH ET AL.

Examiner

Alexander Thomas

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) 11-18,20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7-10,19,22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/26/07.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Specification

1. The substitute specification filed 1/13/05 has been entered.

Election/Restrictions

2. This application contains claims 11-18, 20 and 21 drawn to an invention nonelected with traverse in the reply filed on 7/16/07. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. Concerning applicant's comments regarding the restriction requirement, this requirement was made **Final** in the previous office action. It is very clear that claim 11 does not include the special technical feature of claim 1, namely that the OSB boards are *bonded together* in multiple layers. Claim 11 merely states that the outer layer is connected to the inner layer.
3. This application contains claims 11-18, 20 and 21 drawn to an invention nonelected with traverse in the reply filed on 7/16/07. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4, 7-10, 19, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima ('762) in view of Sean et al ('167) and either DE 2606666 or Renner ('943). The primary reference discloses a building board comprising a plurality of wood boards 4 which are disposed side by side and bonded together in multiple layers wherein interspaces are provided between the boards, some of the interspaces may be filled with insulating material; see column 2, line 59 through column 3, line 9 and column 4, lines 39-43. The insulating material may be provided in the outermost layer (claim 22); see column 1, lines 47-55. However, the primary reference does not disclose the use of OSB boards. Sean et al disclose the structural equivalence of wood and OSB boards; see column 1, lines 16-20. It would have been obvious to one of ordinary skill in the art to use OSB boards as the wood boards 4 in the product of the primary reference in view of the teaching of equivalence in Sean et al. Concerning the claimed sizes of the materials, it would have been obvious to one of ordinary skill in the art to make the product of the primary reference using boards of any size since a change in size is generally recognized as being within the level of ordinary skill in the art (claims 7-10). Regarding the use of a plastic mat in the building board (claims 4 and 23), the reference discloses the placement of a fabric layer in his board; see column 4, lines 39-43. It would have been obvious to one of ordinary skill in the art to select any well-known material, such as plastic fabric, as the fabric layer in the product of the primary reference since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Concerning claim 23, Nakajima discloses that

his "interposed material", i.e. the fabric layer, can be positioned "between at least two of the layers" dependent on its contemplated use; see column 2, lines 10-14. Therefore, it would have been obvious to one of ordinary skill in the art to place the fabric material between an outermost layer and a second layer in the product of Nakajima depending on the function of its contemplated use. With respect to the nail plates, DE 2606666 or Renner ('943) disclose the structural equivalence of the use of nail plates, adhesives etc. in bonding boards together; see the Abstract of ('666) and column 4, lines 38-42 or ('943). It would have been obvious to one of ordinary skill in the art to use nail plates to bond together the boards in the product of the primary reference in view of the teachings in the secondary references to provide the desired structural properties for a particular end use. Regarding the position of the nail plates, it would have been obvious to one of ordinary skill in the art to place the nail plates between a second layer and a third layer of the product of Nakajima in order to provide a strong joint between parts of the individual layers.

Response to Arguments

6. Applicant's arguments have been considered but are not deemed persuasive. Applicant argues the nail plate in Renner and DE 2606666 "span a gap" between boards arranged end-to-end and that this differs from the instant invention. However, this is simply not true. Neither reference is limited to the use of plates to join boards end-to-end. Renner clearly discloses a nail plate 75 joining boards that are not end-to-end; see Figure 3. Even if these references were limited to joining boards end to end, one of ordinary skill in the art would instantly recognize that the nail plates could be

used to reinforce any type of butt joint whether it be end-to-end or otherwise.

Furthermore, the instant claims do not define any structural relationship between the nail plates and the board other than the nail plates being positioned between layers of the board. Such a structure would clearly result in the prior art product if nail plates were used to join the individual pieces in an intermediate layer of the board.

Concerning applicant's comments regarding the potential Finality of this office action, applicant argues that it was unclear in the previous office action of 8/2/07 whether claim 2 or 3 is rejected in view of Nakajima and Sean, and further in view of DT 2606666 or Renner, and that it is unclear whether said rejection refers DE 2606666. The use of numeral "2" and "DT" in paragraph 4 of the previous office action are obvious typographical errors. It is clear from the record that the rejection refers to claim 3 since claim 3 was the only claim containing a reference to a nail plate. It is also clear that the rejection is relying on DE 2606666 since that was the only document cited containing the numerals "2606666". This would have been clear to even an inexperienced attorney, and if not, the attorney could have easily contacted the examiner by phone for clarification. Therefore, the issues were clear in the office action of 8/2/07 and a Final rejection at this time is not improper.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Thomas whose telephone number is 571-272-1502. The examiner can normally be reached on 6:30-4:00 M-THUR.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Thomas/
Primary Examiner
Art Unit 1794